

Application No. 10/758,756
Amendment Dated 1/26/06
Reply to Office Action of October 17, 2005

REMARKS/ARGUMENTS

Applicants hereby confirms the election to prosecute the invention of Group I and sub-species Ai, Bi and Ci, which included original claims 1 - 2, 4 - 5, 10 - 11 and 18 - 19. This election is now being made without traverse.

Applicants have made the above election without prejudice to its right to file divisional applications directed to the non-elected inventions.

Claim 1 has been amended to include the limitation of claim 2 therein and also to more particularly point out patentably novel features of this invention.

Specifically, claim 1 has been amended to more broadly recite the fact that the adhesive is applied to a surface of a label to cause "at least one region" to be substantially devoid of adhesive. Originally presented claim 1 specified that plural regions were substantially devoid of adhesive. Support for this amendment can be found on page 5, line 8.

Claim 1 has also been amended to include the limitation of claim 2 therein; namely, that the step of applying the fluid to fill in regions devoid of the adhesive is carried out by applying the fluid to the container. Claim 1 has further been amended to make it clear that this step of applying a fluid to the container is carried out by applying the fluid in "selected locations in substantial alignment only with regions ... that are substantially devoid of said adhesive." (emphasis added) In other words, the fluid employed to fill in the voids is not applied uniformly over the entire surface of the film to cover pre-applied adhesive regions. Rather, the fluid is applied substantially only to regions of the container aligned with those regions on the label substantially devoid of the adhesive.

Claim 2, the subject matter of which has now been incorporated into claim 1, was

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rejected "under 35 U.S.C. 103(a) as being unpatentable over Krish et al. as applied to claim 1 above and further in view of Reese et al. (U.S. 6290119)."

In rendering this rejection the Examiner acknowledged that Krish is silent as to applying any fluid to a container in selected locations that align with regions of the surface of a label that are substantially devoid of an adhesive. The Examiner takes the position that it is known in the label art to attach a label to a container using two adhesives, one adhesive being applied to the label and the other adhesive being applied to the container, as taught by Reese; referring to column 6, lines 19 – 25 and 34 – 37. The Examiner then asserts that it would have been obvious to apply the adhesive to the label and a fluid/adhesive to a container in the method of Krish because such a method is known in the art as taught by Reese, where only the expected results would be have been achieved.

Applicants submit that claim 1, particularly as amended herein, is patentably novel over the combination of Krish and Reese et al., as applied in the previous Office Action for at least three reasons. First, neither Krish et al. nor Reese et al. addresses the problem now specified in present method claim 1 of first applying an adhesive to the surface of a label in a non-uniform manner to cause at least one region of the surface to be devoid of the adhesive and then applying a fluid to the container in selected locations in substantial alignment only with regions devoid of the adhesive. Second, there is absolutely no motivation for modifying the label structure disclosed in Krish by separating the two adhesive components applied to the label and intended to act in cooperation with the container into a method wherein one of the components is applied to the label and the other component is applied to a container. Third, even if the teachings in Krish

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et al. and Reese et al. were properly combinable, the combined teaching would not result in the method specified in claim 1. Specifically, Reese et al. does not suggest that an adhesive component applied to the container be applied only in selected regions that would coincide with voided regions free of adhesive on the label. In order for the adhesive components to cooperate in the manner disclosed in the Krish et al. patent any adhesive applied to a container as suggest by Reese et al. would need to be aligned with an adhesive material of the label to cooperate therewith in sealing the label to the container. In other words, the combination of Krish et al. and Reese et al. would still result in a method wherein the adhesive component applied to the label and the adhesive component applied to the container would cooperate, e.g., engage each other, to provide the desired sealing action.

In distinction, method claim 1 clearly specifies that the fluid employed to the container is employed in selected regions in substantial alignment only with regions of the label surface that are devoid of adhesive. This is not surprising since applicants' method addresses an entirely different problem than the methods disclosed in either the Krish et al. and Reese et al. patents; namely, filling in unsightly voids in the adhesive pattern with a fluid in a manner that does not affect or alter the adhesive property of the adhesive applied to the label.

In view of the above remarks applicants submit that claim 1, particularly as amended herein, sets forth patentably novel subject matter and respectfully requests and indication to that effect.

Claim 4 is dependent upon claim 1 and specifies that the fluid applied to the container has a clarity compatible with the clarity of the adhesive. Applicants submit that this method step is

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neither disclosed nor suggested in the prior art of record. In applicants' invention it is highly desirable that the clarity of the fluid applied to the container be compatible with that of the adhesive since the fluid is intended to fill in unsightly voids. If the clarity was not compatible, the undesirable appearance of the voided region would not be altered. Neither the Krish et al nor Reesc et al. patents are remotely concerned with the visual aspects of the adhesive. In fact, since both of the adhesives in the Krish et al. patent are actually disposed substantially uniformly over the surface of the label, there is no indication that clarity is even an issue. Thus, there is absolutely no motivation to select a fluid to be applied to the container with a clarity that is compatible with the clarity of the adhesive applied to the label.

Claim 5 is dependent upon claim 1 and specifies the step of selecting an adhesive as the fluid being applied to the container. The method step specified in claim 5 in combination with the method step specified in claim 1 is neither shown nor suggested by the prior art of record and therefore claim 5 is patentable thereover.

Although claim 6 is directed to a non-elected species, it is dependent from method claim 1, which is generic to both the species wherein the fluid applied to the container is an adhesive and wherein the fluid applied to the container is a non-adhesive. In view of the fact that claim 1 sets forth patentably novel subject matter, claim 6 should be retained in this application and also indicated to be allowable.

Claim 7 is dependent upon claim 6 and specifies a preferred group of non-adhesive fluids that are applied to the container. Claim 8 is dependent upon claim 7 and specifies that the glycols referred to in claim 7 include epoxy end-cap polypropylene glycol and alcohol flow aids.

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Claim 9 is dependent upon claim 7 and specifies that the alcohol flow aids include propoxylated neopentyl glycol. The features specified in claims 7, 8 and 9, in combination with the method steps in the claims from which they depend are neither shown nor suggested in the prior art of record and therefore claims 7, 8 and 9 are submitted to be patentable thereover.

Claim 18 is dependent upon claim 1 and specifies that a radiation curable adhesive is selected as the adhesive component applied to the label. Claim 21 is dependent upon claim 1 and specifies that a cold glue adhesive is the adhesive component applied to the label. The steps of applying a radiation curable adhesive and a cold glue adhesive to the label, as specified in claims 18 and 21, respectively, in combination with the method specified in parent claim 1 from which each depends is neither shown nor suggested in the prior art of record and therefore claims 18 and 21 are submitted to be patentable thereover.

Applicants have cancelled method claims specifically directed to applying the fluid to the label, as opposed to the container, without prejudice to filing a continuing application directed to this latter method.

Applicants also have cancelled claims which originally were dependent upon claim 2, in view of the fact that the method steps of claim 2 have been incorporated into claim 1 and claim 2 has been cancelled.

Claims 24 – 34 have been cancelled in view of the fact that they are directed to the non-elected apparatus claims, without prejudice to applicants' right to file a divisional application related to those claims.

Applicants have added new method claim 35, dependent upon claim 1, to specify the

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most preferred method of this invention wherein regions on the label substantially devoid of adhesive are the result of the adhesive being transferred to the surface of the label from a transfer pad having a discontinuity therein aligned with the surface of the label, whereby the surface of the label aligned with the discontinuity is substantially devoid of the adhesive. The features specified in claim 35, in combination with the features specified in independent claim 1 are neither shown nor suggested by the prior art of record and therefore claim 35 is submitted to be patentable thereover.

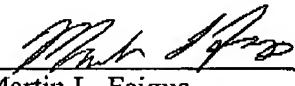
In view of the above remarks applicants submit that all of the claims presented for consideration herein set forth patentably novel subject matter and an indication to that effect is respectfully requested.

Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOV, LTD.

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